

REMARKS

Claims 34 and 36 through 44 are pending in this Application. Claims 34, 36 through 41 and 43 have been amended and claims 35 and 45 cancelled. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure, noting that the limitations of claims 35 and 45 have been incorporated into claim 34. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 34 through 45 were rejected under the second paragraph of 35 U.S.C. § 112.

In the statement of the rejection the Examiner asserted that independent claim 34 is indefinite as to whether the second isolation region or the second active region is in contact with the insulating layer. This rejection is traversed.

Initially, Applicants maintain that one having ordinary skill in the art would have harbored no doubt as to how to interpret claim 34 in light of and consistent with the written description of the specification, notably Fig. 2 and the related discussion thereof in the written description. That is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993).

At any rate, claim 34 has been amended by, *inter alia*, addressing the issue raised by the Examiner.

Applicants submit that one having ordinary skill in the art would have no difficulty understanding the scope of the now claimed invention, particularly when reasonably interpreted in light of and consistent with the written description of the specification which, again, is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, *supra*.

Based upon the foregoing, it should be apparent that the imposed rejection of claims 34 through 45 under the second paragraph of 35 U.S.C. § 112 is not viable and, hence, solicit withdrawal thereof.

Claims 34, 35 and 45 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Kumagai.

This rejection is traversed. Applicants stress that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In imposing the rejection under 35 U.S.C. § 102, the Examiner is required to specifically identify where in each feature of a claimed invention is to be found in an applied reference, particularly where such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). Indeed, there are significant differences between the claimed semiconductor device and any semiconductor device disclosed by Kumagai that scotch the factual determination that Kumagai discloses a semiconductor device identically corresponding to that claimed.

Specifically, as previously pointed out, claim 34 has been amended by incorporating the limitations of claims 35 and 45 therein. In addition, claim 35 has been amended to recite that the second active region includes a plurality of MOS field effect transistors of the second

conductivity type. Further, in accordance with independent claim 34, the plurality of MOS field effect transistors of the first conductivity type are isolated from each other by the first partial isolation region, and the plurality of MOS field effect transistors of the second conductivity type are isolated from each other by the second partial isolation region. The device in claim 34 further contains a perfect isolation region which includes a third insulating film situated between the first active region and the second active region. The perfect isolation film is in contact with the insulating layer, and the first and second active regions are electrically isolated from each other by the perfect isolation region. Claim 34 further specifies that the film thickness of the semiconductor layer located at the first active region is identically to the thickness of the semiconductor layer located at the second active region. Further, in accordance with the device defined in independent claim 34, a lower portion of the semiconductor layer located at the first active region is provided under the first insulating film as the lower first semiconductor layer, and each portion of the semiconductor layer located at the first active region is electrically connected with each other integrally by the first lower semiconductor layer. A lower portion of the semiconductor layer located at the second active region is provided under the second insulating film as the second lower semiconductor layer, and each portion of the semiconductor layer located at the second active region is electrically connected with each other integrally by the second lower semiconductor layer. The device defined in independent claim 34 further contains an electrode in respective semiconductor layers of the first active region and the second active region, wherein each electrode is held at a ground potential or a predetermined fixed potential.

It is not apparent wherein Kumagai discloses or suggests a semiconductor device containing the above argued features. Further, the above argued features are functionally

significant. This is because the structure of the claimed invention enables complete isolation of the first transistor formation region from the second transistor formation region, thereby effectively preventing latch up.

The above argued functionally significant differences between the claimed semiconductor device and any semiconductor device disclosed by Kumagai **undermines the factual determination** that Kumagai discloses a semiconductor device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., supra; Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986)*.

Applicants, therefore, submit that the imposed rejection of claims 34, 35 and 45 under 35 U.S.C. § 102 for lack of novelty as evidenced by Kumagai is not factually viable and, hence, solicit withdrawal thereof.

Claims 36 and 37 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Kumagai in view of Ogooh.

Claims 38 through 40 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Kumagai in view of Nagakubo et al.

Claims 41 through 44 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Kumagai in view of Nagakubo et al. and Yatsuda et al.

Each of the above rejections under 35 U.S.C. § 103 is traversed. Specifically, each of the rejected claims depends directly or indirectly from independent claim 34.

Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 34 under 35 U.S.C. § 102 for lack of novelty as evidenced by

Kumagai. The additional references to Ogoh, Nagakubo et al. and Yatsuda et al. do not cure the previously argued deficiencies of Kumagai. Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicants do not agree that the requisite fact-based motivation has been established, the claimed inventions would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 36 and 37 under 35 U.S.C. § 103 for obviousness predicated upon Kumagai in view of Ogoh, the imposed rejection of claims 38 through 40 under 35 U.S.C. § 103 for obviousness predicated upon Kumagai in view of Nagakubo et al. and the imposed rejection of claims 41 through 44 under 35 U.S.C. § 103 for obviousness predicated upon Kumagai in view of Nagakubo et al. and Yatsuda et al., are not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Arthur J. Steiner
Registration No. 26,106

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 AJS:bjs:ntb
Facsimile: 202.756.8087
Date: December 27, 2005

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